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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/690,791

10/22/2003

Alan R. Hirsch

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EXAMINER

FLOOD, MICHELE C

ART UNIT

PAPER NUMBER

1655

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/14/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/690,791

Applicant(s)

HIRSCH, ALAN R.

Examiner

Michele Flood

Art Unit

1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 17, 26, 27 and 31-40 is/are pending in the application.
- 4a) Of the above claim(s) 5-11, 27 and 31-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11/22/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I, Claims 1-4 and Claim 26, in the reply filed on December 13, 2006 is acknowledged. The traversal is on the grounds that the claims do not require a different field of search and there would not be serious burden for the examiner to examine all of the inventions. This is not found persuasive because contrary to Applicant's analysis of the claims the nine different inventions are directed to nine methods encompassing different experimental parameters, different process steps, different concentrations of a mixture of ingredients, wherein the ingredients are not necessarily the same; and, thereby provide different functional effects as evidenced by the claims themselves. These methods are independent since they are not disclosed as capable of use together, they have different modes of operation, they have different functions, and/or they have different effects. One would not have to practice the various methods at the same time to practice just one method alone.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-4 and 26 are under examination.

Claim Rejections - 35 USC § 112

Claims 1-4 and 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Claims 1-4 and 26 either recite, or depend upon a claim which recites "A method of modifying perception of body weight, comprising the step of: administering to a person for inhalation an effective amount of a composition comprising a hedonically positive mixture of a floral odorant and a spice odorant in effective amounts such that the person perceives the body weight to be about 5-10% less than actual body weight". It is deemed that Applicant has not set forth a representative number of examples in order to reasonably verify possession of such a potentially enormous number of a "hedonically positive mixture of a floral odorant and a spice odorant".

The MPEP states that written description for a genus can be achieved by a representative number of species within a broad generic. It is unquestionable that the claims are broad generics, with respect to *all* hedonically positive mixtures of a floral and a spice odorant. The possible variations of mixtures are limitless. While Applicant has disclosed several types of floral odorants and several types of spice odorants (on page 6, lines 7-20), this disclosure is actually a *very few* number in comparison to the enormous, *potentially thousands* of types of floral odorants and spice odorants that can be used in the making of a hedonically positive mixture of the claim-designated

odorants from either a natural plant source or a synthetic source used in the making of perfumes, for instance.

The MPEP states that the purpose of the written description requirement is to ensure that the invention had possession, as of the filing date of the application, of the specific subject matter later claimed by him or her. The courts have stated:

"To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention.' Lockwood v. American Airlines, Inc., 107 F. 3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997); In re Gostelli, 872 F. 2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) ("[T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."). Thus, an applicant complies with the written description requirement "by describing the invention, with all its claimed limitations, no that which makes it obvious," and by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention." Lockwood, 107 F. 3d at 1572, 41 USPQ2d at 1966." Regents of the University of California v. Eli Lilly & Co., 43 USPQ2d 1398. The specification lacks sufficient variety of species of mixtures of a floral odorant and a spicy odorant to reflect this variance in the genus since the specification does not provide sufficient examples of such a genus of mixtures. In fact, the specification fails to provide any example of "a hedonically positive mixture of a floral odorant and a spice

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odorant" detailing the actual ingredients contained therein to provide the functional effect for modifying perception of body weight.

The description requirement of the patent statute requires a description of an invention, not an indication of a result that one might achieve if one made that invention. See *In re Wilder*, 736, F. 2d 1516, 1521, 222 USPQ 369, 372-73 (Fed. Cir. 1984) (affirming rejection because the specification does "little more than outline [goals] appellants hope the claimed invention achieves and the problems the invention will hopefully ameliorate.") Accordingly, it is deemed that the specification fails to provide adequate written description for the genus of "a hedonically positive mixture of a floral odorant and a spice odorant" and does not reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed had possession of the entire scope of the claimed invention and thus, this rejection is proper.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The metes and bounds of Claim 1 are rendered indefinite by the phrase, "such that the person perceives the body weight to be about 5-10% less than actual body weight" because it is unclear as to what body weight Applicant is referring to. Does Applicant intend to direct the subject matter to the body weight of the person that is

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inhaling the odorant or to the body weight of another individual or to the body weight of an inanimate object? The lack of clarity renders the claim very ambiguous.

Claim 1 recites the limitation "the step" in line 2. There is insufficient antecedent basis for this limitation in the claim. Applicant may overcome the rejection by replacing "the" with a.

Claim 2 recites the limitation "odorants" in line 2. There is insufficient antecedent basis for this limitation in the claim.

All other cited claims depend directly or indirectly from rejected claims and are, therefore, also, rejected under U.S.C. 112, second paragraph for the reasons set forth above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Flood whose telephone number is 571-272-0964. The examiner can normally be reached on 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


MICHELE FLOOD
PRIMARY EXAMINER

Michele Flood
Primary Examiner
Art Unit 1655

MCF
March 4, 2007